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10/618,499	07/11/2003	John C. Colvin	124-0002US-D	5385

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EXAMINER

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ART UNIT	PAPER NUMBER
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1711

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/618,499
Filing Date: July 11, 2003
Appellant(s): COLVIN ET AL.

Sean McDermott
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/06/2006 appealing from the Office action mailed 8/10/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The reference of Diehr et al. is U.S. Patent No. 3,870,665.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,458,238

MENDTE et al.

10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-15, 17-34, 37-39, and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim 41 introduces the new limitation “about 0.1 to less than 2% by weight” of the moisture content in the substrate, has no proper support in the specification as originally presented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-15, 17-34, 37-39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diehr et al. (US Pat. 3,870,665), in view of Mente et al. (US Pat. 6,458,238).

In regards to claims 1-5, 17-23, 33-34, and 37-41, Diehr teaches a sheet or board for building purposes, comprising a lignocellulosic material, impregnated with an organic polyisocyanate (see abstract; col. 1, ln. 6-27). The lignocellulosic material used can be chipboard, fiberboard, wood, or straw (see col. 1, ln. 32-34; col. 4, ln. 46-51). The isocyanate is diphenylmethane diisocyanate (methylene diphenyl diisocyanate) (see Example 1). Diehr further teaches the surface of the board to be smooth (see Example 8).

Diehr further teaches the lignocellulosic material containing 7% moisture content before impregnation of polyisocyanate (see Examples 9-10). However, Diehr does not teach the use of lignocellulosic material containing about 0.1 to 2.5%.

Mente teaches lignocellulosic articles, wherein the lignocellulosic material contains a moisture content of 2-15% weight for the binder resin to be efficient at forming the article (see abstract; col. 4, ln. 34-41), approximate to the instantly claimed range. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the lignocellulosic material having the moisture content, as taught by Mente, in the making of Diehr's sheet or board, for the purpose of enhancing the efficacy of the forming of the article. Moreover, the water content limitation is only in the intermediate, not the final product as claimed, thus having insignificant patentable weight.

Although Diehr is silent with respect to a low-gloss surface or that the impregnated lignocellulosic material is substantially non-conductive, since the reference teaches the same product containing the same chemical constituents, the board of the reference would inherently

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have the same properties, such as low-gloss surface and substantially non-conductive, as the presently claimed invention.

With respect to process limitations, such as how the lignocellulosic material is being formed or how impregnation is carried out, it has been within the skill in the art that process limitations would have no significant patentable weight when a product claim is being considered. See MPEP 2113.

In regards to claims 6-14 and 24-32, Diehr teaches the lignocellulosic material to be used in building purposes such as veneer, sheets, and the like (see col. 1, ln. 6-21). Hence, although the reference does not specifically teach the material to be used as construction components as recited in the instant claims, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that these structures would have been variations in the use of the lignocellulosic material.

(10) Response to Argument

Applicant's arguments filed 6/10/2005 have been fully considered but they are not persuasive.

With respect to the 112 rejection, Applicants argue that the presently claimed range of moisture content from about 0.1 to less than 2% by weight has proper support because the specification discloses a moisture content of less than 7% and more preferably about 0.1 to 2.5% by weight. However, there is nowhere in the specification to indicate why Applicants would choose to claim a range of less than 2% now. Thus, the 112 rejection is sustained.

In response to applicant's argument that there is no suggestion to combine the references of Diehr and Mente, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mente is used to illustrate that the lignocellulosic material containing a moisture content of 2-15% weight for the binder resin to be efficient at forming lignocellulosic articles, has been taught in the prior art. With respect to the arguments that Mente teaches away from a moisture content of less than 2%, it is hereby noted that negative teachings are also indication of a known fact taught in the prior art. Moreover, the water content limitation is only in the intermediate, not the final product as claimed, thus having insignificant patentable weight.

Thus, the Diehr combination would be obvious over the presently claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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March 14, 2006

Conferees:

James Seidleck



David Wu



**THAO T. TRAN
PATENT EXAMINER**